

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 10/623,588
Appellant : Gary Schlatter
Filed : 07/22/2003
Group Art Unit: 3781
Examiner : Smalley
Docket No. : ORA-005
Customer No. : 021884
Title : DISPENSING CONTAINER

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Sir:

REAL PARTY IN INTEREST

Gary Schlatter is the real party in interest in the above referenced patent application.

RELATED APPEALS AND INTERFERENCES

Neither Appellant's representative nor Appellant is aware of any related appeals and/or interferences affected by or having a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-20 are currently pending and stand finally rejected. Appellant accordingly appeals the Examiner's final rejection of claims 1-20.

STATUS OF AMENDMENTS

A Reply was filed on 11/07/2008 subsequent to the Final Rejection, but was not entered.

As to the amendments filed prior to the Final Rejection, all amendments appear to have been entered and considered.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Claims 1, 8 and 16 are the only independent claims involved in the present Appeal. These claims are summarized below.

In independent claim 1, Appellant has claimed a dispensing container 10 with a selectively removable cap 12 to which a variety of articles may be securely and selectively attached. The dispensing container 10 has a dispensing body 14 in which material 18 for dispensing is stored. The dispensing body 14 has a closed end 24, a side wall 26, an open end 22 through which the material 18 is dispensed and a cap 12 shaped and dimensioned for selectively covering the open end 22 of the dispensing body 14. The cap 12 has a first end 28 shaped and dimensioned for engaging the open end 22 of the dispensing body 14 for secure and selective attachment thereto and a closed second end 30 with a clasp 32 extending therefrom. The clasp 32 has a first arm 48 and a second arm 50. The first arm 48 has a first arcuate member 52 and a first upwardly extending connecting member 54 integrally formed with the cap 12. The second arm 50 has a second arcuate member 56 and a second upwardly extending connecting member 58 integrally formed with the cap 12. The first arm 48 and the second arm 50 are extending from the cap 12 in a spaced relationship and oriented upon the cap 12 so as to overlap in a mating configuration with the first arm 48 lying over the second arm 50. Further, the first arcuate member 52 and the second arcuate member 54 overlap through a substantial portion of their respective arcs. (Specification Pages 5-7)

In independent claim 8, Appellant claims a dispensing container 10 with a selectively removable cap 12 to which a variety of articles may be securely and selectively attached. The dispensing container 10 has a dispensing body 14 in which material 18 for dispensing is stored. The dispensing body 14 has a closed end 24, a side wall 26, an open end 22 through which the material 18 is dispensed and a cap 12 shaped and dimensioned for selectively covering the open end 22 of the

dispensing body 14. The cap 12 has a first end 28 shaped and dimensioned for engaging the open end 22 of the dispensing body 14 for secure and selective attachment thereto and a closed second end 30 with a clasp 32 extending therefrom. The clasp has a first arm 48 and a second arm 50. The first arm 48 has a first arcuate member 52 extending along an arc of at least 120 degrees and a first upwardly extending connecting member 54 integrally formed with the cap 12. The second arm 50 has a second arcuate member 56 extending along an arc of at least 120 degrees and a second upwardly extending connecting member 58 integrally formed with the cap 12. The first arm 48 and the second arm 50 extend from the cap 12 in a spaced relationship and are oriented upon the cap 12 so as to overlap in a mating configuration with the first arm 48 lying over the second arm 50. Further, the first arcuate member 52 and the second arcuate member 54 overlap through at least a 60 degree arc. (Specification Pages 5-8)

In independent claim 16, Appellant claims a cap 12 to which a variety of articles may be securely and selectively attached. The cap 12 is adapted for use in conjunction with a dispensing body 14 in which material 18 for dispensing is stored. The dispensing body 14 has a closed end 24, a side wall 26, and an open end 22 through which the material 18 is dispensed. The cap 12 is shaped and dimensioned for selectively covering the open end 22 of the dispensing body 14. The cap 12 has a first end 28 shaped and dimensioned for engaging the open end 22 of the dispensing body 14 for secure and selective attachment thereto and a closed second end 30 with a clasp 32 extending therefrom. The clasp 32 has a first arm 48 and a second arm 50. The first arm 48 has a first arcuate member 52 and a first upwardly extending connecting member 54 integrally formed with the cap 12. The second arm 50 has a second arcuate member 56 and a second upwardly extending connecting member 58 integrally formed with the cap 12. The first arm 48 and the second arm 50 extend from the cap 12 in a spaced relationship and are oriented upon the cap 12 so as to overlap in a mating

configuration with the first arm 48 lying over the second arm 50. Further, the first arcuate member 52 and the second arcuate member 54 overlap through a substantial portion of their respective arcs. (Specification Pages 5-7)

Dependent claims 2, 4, 7, 9, 12, 14 and 17 are argued separately and as such as summarized below.

Claims 2, 9 and 17 depend from independent claims 1, 8 and 16, respectively, and all set forth the further limitation that the second arcuate member 56 has a slightly smaller radius of curvature than the first arcuate member 52. (Specification Page 8, lines 10-13)

Claims 4, 7, 12 and 14 all set forth the further limitation that the first upwardly extending connecting member 54 is longer than the second upwardly extending connecting member 58. (Specification Page 8, lines 20-22)

The remaining dependent claims are not argued separately and are, therefore, not addressed in the Summary.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-3, 5, 6, 8-11, 13 and 15-20 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0250386 to Goldberg (Goldberg) in view of U.S. Patent No. 5,996,191 to Christler (Christler).
2. Whether claims 4, 7, 12 and 14 are unpatentable under 35 U.S.C. § 103(a) over Goldberg in view of Christler, and further in view of U.S Patent No. 3,748,703 to Maillocheau (Maillocheau).

ARGUMENTS

I. CLAIMS 1-3, 5, 6, 8-11, 13 AND 15-20 ARE PATENTABLE OVER GOLDBERG IN VIEW OF CHRISTLER

Claims 1-3, 5, 6, 8-11, 13 and 15-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goldberg in view of Christler. With reference to claim 1, Appellant has claimed a dispensing container with a selectively removable cap to which a variety of articles may be securely and selectively attached. The dispensing container has a dispensing body in which material for dispensing is stored. The dispensing body has a closed end, a side wall, an open end through which the material is dispensed and a cap shaped and dimensioned for selectively covering the open end of the dispensing body. The cap has a first end shaped and dimensioned for engaging the open end of the dispensing body for secure and selective attachment thereto and a closed second end with a clasp extending therefrom. The clasp has a first arm and a second arm integrally formed with the cap. The first arm has a first arcuate member and a first upwardly extending connecting member integrally formed with the cap. The second arm has a second arcuate member and a second upwardly extending connecting member integrally formed with the cap. The first arm and the second arm extend from the cap in a spaced relationship and are oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm. Further, the first arcuate member and the second arcuate member overlap through a substantial portion of their respective arcs.

The Examiner that Goldberg teaches a dispensing container with an integrally formed carabineer having arms with arcuate members, but admits the arcuate members of Goldberg fail to overlap along a substantial portion of their respective arcs. In an attempt to overcome the clear deficiencies in the disclosure of Goldberg, the Examiner relies upon the teaching of the hookless connecting ring of Christler, arguing the modification of Goldberg based upon Christler is

motivated by “the benefit of providing stability such that the arms will only separate in either a radial direction or an axial direction, but not both, and, by the benefit of preventing radial detachment”.

In establishing the law governing obviousness-type rejections, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy... This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

With the foregoing in mind, the U.S. Patent & Trademark Office has determined that a *prima facie* case of obviousness is established by meeting three basic criteria. First, the Examiner must show some suggestion or motivation to modify the reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success in modifying the primary reference based upon the teachings of the prior art. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Support for the proposed modification and the reasonable expectation of success must be found in the prior art. MPEP 706.02(j).

Considering the factors required in establishing a *prima facie* case of obviousness, the Examiner has failed to fulfill the requirements of § 103 to set forth a *prima facie* case. First, the motivation suggested by the Examiner for the modification of Goldberg based upon Christler, that is, creating a benefit of providing stability such that the arms will only separate in either a radial

direction or an axial direction, but not both, and, by the benefit of preventing radial detachment, is not supported by the cited references. Christler teaches a hookless ring which is desired to open axially with one hand while using the other hand to attach an object to the ring, but could also be operated with two hands such that the ring is pulled apart a distance “*o*” to separate the arms 14 and 16. With that being said, the “so called” benefit asserted by the Examiner does not result from the teachings of Christler.

More specifically, the Examiner argues that Christler teaches that it is known to modify the length of overlap of resilient arms in order to overcome material bias to obtain a desired opening force between the elements. This is an interesting teaching which is not found in Christler and, even if found in Christler, would provide no motivation for the modification of Goldberg as suggested by the Examiner.

There is no logical reason why one would modify the carabineer of Goldberg to include a hookless connecting ring as taught by Christler. It does not logically flow to make the arms of the carabineer of Goldberg overlapping and thus not function as intended just because Christler teaches a hookless connecting ring with overlapping arms. Quite simply, Christler provides no benefit to Goldberg. In fact overlapping arms would make Goldberg inoperative for the functionality desired by Goldberg. Carabineers are well known to be operable without the need for pressing the pivoting arm with a finger. One simply grabs the carabineer and pushes it against the object one desires to attach thereto and the arm moves itself. The device of Christler requires the user to either push or pull apart the arms with their fingers in order for it to operate. Thus, there is no logical motivation to modify Goldberg in view of Christler to create a non-operable carabineer or if operable to create a carabineer which is much more difficult to operate.

Neither Goldberg nor Appellant has a desire to provide for arms which move in an axial direction. In complete contrast, Christler preferably operates in an axial direction. Why would one look to something that is intended to operate in an axial direction to add a benefit to something operating in a radial direction?

Ultimately, there is no motivation to combine these references and, even if combined, it is not shown how Appellant's claimed invention is the logical result.

In independent claim 8, Appellant has specifically claimed the first arm includes a first arcuate member extending along an arc of at least 120 degrees and a first upwardly extending connecting member integrally formed with the cap. The second arm includes a second arcuate member extending along an arc of at least 120 degrees and a second upwardly extending connecting member integrally formed with the cap. The first arm and the second arm are oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm, the first arcuate member and the second arcuate member overlapping through at least a 60 degree arc.

The Examiner addresses these limitations by again making unsupported assumptions. The assumption relates to the size of Christler and is not based upon the teachings of Christler. The overlap in Christler is certainly not 60 degrees and there is no overlap in Goldberg. So, how is it taught by the references that when combined a 60 degree overlap is the result? Although Christler does indicate the overlap can be adjusted, his desire is to have it be four times the width of the material the ring is made from. Christler indicates no desire to have the overlap be 60 degrees and neither reference indicates the arc length of each arm being at least 120 degrees

The arguments presented above generally deal with the "pre-KSR world". In view of the new "Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc.*", Appellant has attempted to address

various issues that may not have been contemplated by the Examiner prior to the rendering of a decision in *KSR*. In particular, the Examination Guidelines set forth various proposed rationales for articulating why a claimed invention would in fact be obvious. After reviewing the proposed rationales and considering the rejection in the outstanding application, it is quite possible one might attempt to apply the following rationales in supporting or explaining the rationale for obviousness in the present application; (1) applying a known technique to a known device ready for improvement to yield predictable results; (2) known work in one field of endeavor may prompt variation of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; or (3) some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

With regard to the first rationale listed above, that is, applying a known technique to a known device, the Examination Guidelines indicate that an Examiner must first provide a finding that the prior art contains a base device upon which the claimed invention can be seen as an improvement. Presumably, the base device would be that disclosed by Goldberg. Thereafter, the Examiner must present a finding that the prior art contained a known technique that is applicable to the base device. Presumably, the Examiner would argue this is taught by Christler. Finally, the Examiner must present a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system. This is where the Examiner would certainly fail to find support for the factual inquiry required under *KSR*. In particular, and as fully discussed above, Goldberg fails to teach a carabiner with overlapping arms and Christler fails to teach a resilient clasp on a cap as claimed. Christler merely teaches a hookless locking ring. With this in mind, why would the claimed invention be a

predictable modification of the cited references? What is truly the predictability of adding a hookless locking ring to a dispensing cap and resulting in the claimed invention? The only result is that the design of Goldberg would now be altered in an undesirable fashion. In fact, the carabineer structure of Goldberg would no longer function as intended.

As to the second rationale for obviousness, that is, that known work in one field of endeavor may prompt variation of it for use in either the same field or a different one based on design incentives or other market forces, this rationale first requires that the scope and content of the prior art, whether in the same field of endeavor as that of Appellant's invention or a different field of endeavor, included a similar analogous device. Presumably, the scope and content of the prior art would include the disclosures of Goldberg and Christler. Thereafter, the Examiner must provide a finding that there were design incentives or market forces, which would have prompted adaptation of the known device. At the current time, and absent the disclosure of the present application, there are no design incentives or market forces, which would have prompted one to modify either Goldberg or Christler so as to read upon the pending claims. Further, and even if one were able to find such incentives, the Examiner must find that the differences between the claimed invention and the prior art were encompassed in known variations or in principles known in the prior art. Once again, Goldberg and Christler fail to provide support for this required finding, as what Appellant has claimed is not encompassed in these references. The Examiner's rationale regarding varying or obtaining a particular biasing force is has nothing to do with the claimed invention.

Finally, and with regard to the third rationale, that is, that some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention, the Examiner would once again fail to find a sufficient finding of obviousness to support a rejection under 35 U.S.C. §

103 and KSR. In particular, this rationale requires that the Examiner present a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Presumably, Goldberg and Christler are the references and, as discussed above, neither of these references provide any teaching to support the concept that one would desire to provide a clasp as claimed on a dispenser cap. Again, the Examiner's rationale regarding varying or obtaining a particular biasing force is has nothing to do with the claimed invention.

With regard to claims 2, 9 and 17, and contrary to the Examiner's assertion, there is no showing in Goldberg of a second arm having a smaller radius of curvature than the first arm. The arms in Goldberg have the same radius of curvature. Although one is shorter than the other they both still have the same radius of curvature and as discussed above there would be no reason to modify the carabineer of Goldberg in view of Christler to create such structure.

In view of the above remarks, it is respectfully requested that the rejection of claims 1-3, 5, 6, 8-11, 13 and 15-20 under Goldberg in view of Christler be reversed.

II. CLAIMS 4, 7, 12 AND 14 ARE PATENTABLE OVER GOLDBERG IN VIEW OF CHRISTLER, AND FURTHER IN VIEW OF MAILLOCHEAU.

Claims 4, 7, 12 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goldberg in view of Christler, and further in view of Maillocheau.

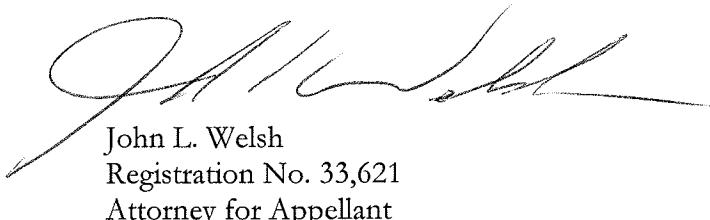
With regard to all of these claims, they set forth that the first upwardly extending connecting member is longer than the second upwardly extending connecting member and it is admitted that neither Goldberg nor Christler teach this structure. As such, the Examiner has relied upon Maillocheau, which teaches nothing more than a clip hook, to somehow teach changing the length of the arms in Goldberg due to a desire to increase the force required to open the gate. The Examiner believes this is a mere reversal of parts. Again, the benefit proposed by the Examiner is purely made up and does not flow from the references themselves. To modify Goldberg as suggested by the Examiner would be contrary to the operation of a carabineer. The long arm is meant to pivot without the need of fingers pushing on either arm, such that a user may merely use one hand and push the long arm against the object they desire to attach to the carabineer. The pushing causes the arm to pivot without the need for finger manipulation. The clip of Maillocheau includes coupling elements at the end of each arm and as such would not operate as intended by Goldberg's carabineer, thus one looking to modify Goldberg would have no reason to look to Maillocheau. The so called benefit created by the Examiner is in fact not a benefit to Goldberg, but purely made up in order to fabricate a rejection.

In view of the above remarks, it is respectfully requested that the rejection of claims 4, 7, 12 and 14 as being unpatentable over Goldberg in view of Christler, and further in view of Maillocheau be reversed.

III. CONCLUSION

In conclusion, Appellant has now shown that the references cited by the Examiner neither disclose nor suggest the claimed invention. Further, Appellant has shown that the reasons underlying the benefits of the modifications suggested by the Examiner are in fact not benefits, are not benefits taught by the references themselves and are benefits contrary to the desired operation of Goldberg. Therefore, it is respectfully requested that the outstanding rejection of claims 1-20 be reversed. Still further, prosecution after an Appeal Brief is filed has become commonplace, which is an absolute travesty to the patent system, and steps should be taken to curb this practice in the future.

Respectfully submitted,



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CLAIMS APPENDIX

1. A dispensing container including a selectively removable cap to which a variety of articles may be securely and selectively attached, comprising:

a dispensing body in which material for dispensing is stored, the dispensing body including a closed end, at least one side wall and an open end through which the material is dispensed;

a cap shaped and dimensioned for selectively covering the open end of the dispensing body, the cap including a first end shaped and dimensioned for engaging the open end of the dispensing body for secure and selective attachment thereto and a closed second end including a clasp extending therefrom;

the clasp including a first arm and a second arm, the first arm includes a first arcuate member and a first upwardly extending connecting member integrally formed with the cap, and the second arm includes a second arcuate member and a second upwardly extending connecting member integrally formed with the cap; the first arm and the second arm extending from the cap in a spaced relationship and being oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm, the first arcuate member and the second arcuate member overlapping through a substantial portion of their respective arcs.

2. The dispensing container according to claim 1, wherein the second arcuate member has a slightly smaller radius of curvature than the first arcuate member.

3. The dispensing container according to claim 2, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.

4. The dispensing container according to claim 3, wherein the first upwardly extending connecting member is longer than the second upwardly extending connecting member.
5. The dispensing container according to claim 1, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.
6. The dispensing container according to claim 1, wherein the first arm and the second arm are positioned approximately 2 mm or less from one another.
7. The dispensing container according to claim 1, wherein the first upwardly extending connecting member is longer than the second upwardly extending connecting member.
8. A dispensing container including a selectively removable cap to which a variety of articles may be securely and selectively attached, comprising: a dispensing body in which material for dispensing is stored, the dispensing body including a closed end, at least one side wall and an open end through which the material is dispensed; a cap shaped and dimensioned for selectively covering the open end of the dispensing body, the cap including a first end shaped and dimensioned for engaging the open end of the dispensing body for secure and selective attachment thereto and a closed second end including a clasp extending therefrom; the clasp including a first arm and a second arm, the first arm includes a first arcuate member extending along an arc of at least 120 degrees and a first upwardly extending connecting member integrally formed with the cap, and the second arm includes a second arcuate member extending along an arc of at least 120 degrees and a second upwardly extending connecting member integrally formed with the cap; the first arm and the

second arm extending from the cap in a spaced relationship and being oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm, the first arcuate member and the second arcuate member overlapping through at least a 60 degree arc.

9. The dispensing container according to claim 8, wherein the second arcuate member has slightly smaller radius of curvature than the first arcuate member.

10. The dispensing container according to claim 9, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.

11. The dispensing container according to claim 9, wherein the first arm and the second arm are positioned approximately 2 mm or less from one another.

12. The dispensing container according to claim 9, wherein the first upwardly extending connecting member is longer than the second upwardly extending connecting member.

13. The dispensing container according to claim 8, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.

14. The dispensing container according to claim 8, wherein the first upwardly extending connecting member is longer than the second upwardly extending connecting member.

15. The dispensing container according to claim 8, wherein the first arcuate member includes a proximal end connected to the first upwardly extending connecting member and a free distal end and the second arcuate member includes a proximal end connected to the second upwardly extending member and a free distal end, and wherein the distal ends of both the first arcuate member and the second arcuate member are tapered.

16. A cap to which a variety of articles may be securely and selectively attached, the cap being adapted for use in conjunction with a dispensing body in which material for dispensing is stored, the dispensing body including a closed end, at least one side wall and an open end through which the material is dispensed, wherein the cap is shaped and dimensioned for selectively covering the open end of the dispensing body, the cap comprising: a first end shaped and dimensioned for engaging the open end of the dispensing body for secure and selective attachment thereto and a closed second end including a clasp extending therefrom; the clasp including a first arm and a second arm, the first arm includes a first arcuate member and a first upwardly extending connecting member integrally formed with the cap, and the second arm includes a second arcuate member and a second upwardly extending connecting member integrally formed with the cap; the first arm and the second arm extending from the cap in a spaced relationship and being oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm, the first arcuate member and the second arcuate member overlapping through a substantial portion of their respective arcs.

17. The cap according to claim 16, wherein the second arcuate member has slightly smaller radius of curvature than the first arcuate member.

18. The cap according to claim 17, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.

19. The cap according to claim 16, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.

20. The cap according to claim 16, wherein the first arm and the second arm are positioned approximately 2 mm or less from one another.

EVIDENCE APPENDIX

Not Applicable

RELATED PROCEEDINGS APPENDIX

Not Applicable